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EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT

2686

PAPER NUMBER

DATE MAILED: 11/10/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,007

Applicant(s)

ARAZI ET AL.

Examiner

Joy K Contee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 1-3,5,8,9,11,13,16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 1-3,5,8,9,11,13,16, and 17 are objected to because of the following informalities: using capital letters in words such as "Base Stations" and "Switch" and "Time of Day" is not necessary in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 1, and thus its dependents 2-10, the phrase "smoothing a plurality of signals" renders the claim indefinite because the term "smoothing" is just merely repeated in claim form, but not clearly defined in the specification.

The Examiner has not examined independent claim 1, nor its dependents 2-10, based on the merits

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 11-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 12 of U.S. Patent No. 6,430,395 ('395). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 11-18 of the instant application encompass the scope of 1-10 and 12 of '395.

Regarding claim 11, and thus its dependents 12-18, of the instant application, it is described wherein a wireless communication system comprising at least two base stations and at least one switch in communication with the base stations, a method of performing handoff of a session from a base station connected with a mobile unit to a neighboring base station, wherein an instance of a low-level communications protocol is running at the base station and further comprising: at the switch, determining when to perform handoff to a selected one of the neighboring base stations; at the selected one

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of the neighboring base stations, creating a copy of the low-level communications protocol, including at least a synchronized time of day (TOD) parameter; and from the switch, sending a command to stop communication with the mobile unit at a specified TOD to the Base Station connected with the mobile unit and sending a command to start communication with the mobile unit at the specified TOD to the selected one of the neighboring base stations; and updating session status tables in the switch and in the base stations. In comparison, claims 1,2,9,10 and 12 '395, describe, *inter alia*, for each connection of a mobile unit with a base station, running an instance of the low level protocol at the base station connected with the mobile unit and running an instance of the high-level protocol at the switch wherein the switches maintain status tables for calls and connections that they are handling and maintain copies of each other's status tables and when a switch updates one of its status tables it sends the updated status table to the other switches. Further, another dependent claims describes wherein in the switch, for each call, maintaining a table of connections comprising information selected from a group including handle of low-level protocols, number of candidate base stations for handoff, list of candidate base stations for handoff and list of handoff status for each candidate base station. '395 fails to explicitly describe from the switch, sending a command to stop communication with the mobile unit at a specified TOD to the Base Station connected with the mobile unit and sending a command to start communication with the mobile unit at the specified TOD to the selected one of the neighboring base stations; and updating session status tables in the switch and in the base stations. However, the claims as written suggest the switch has high-level protocol capability

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which includes: "quality of service management"; "access to status information ". Thus, since the switch maintains a table including list of candidate base stations for handoff for each call, the specific commands for handoff would be encompassed in the implied handoff procedure.

Omission of element and its function in combination is obvious expedient if remaining elements perform same function as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dolan, U.S. Patent No. 6,628,632, discloses a method and apparatus for permitting direct handoff between base stations in a wireless network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 703-308-0149. The examiner can normally be reached on 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

J Contee

Joy Contee

October 31, 2003

Marsha D Banks-Harold

MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
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